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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,871	08/06/2003	Noam Kedem	246/217	7627
7590	03/22/2005		EXAMINER	
DR. MARK FRIEDMAN LTD. c/o Bill Polkinghorn Discovery Dispatch 9003 Florin Way Upper Marlboro, MD 20772			FIGUEROA, FELIX O	
			ART UNIT	PAPER NUMBER
			2833	
DATE MAILED: 03/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/634,871	KEDEM, NOAM	
	<b>Examiner</b>	<b>Art Unit</b>	
	Felix O. Figueroa	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 February 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 3,4,7-10 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 3,4,7-10 and 13-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on December 7, 2004 and February 3, 2005 have been entered.

### ***Specification***

The amendment filed February 3, 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: New claims 14 and 18 recite "a peripheral device that is electrically connected to the system board only via said second port" and "said peripheral device is electrically connected t the system board only via said inward-facing port", respectively. However, the specification does not appear to provide basis for the exclusion of other electrical connections within the peripheral device and the system board.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claims 14 and 18 recite "a peripheral device that is electrically connected to the system board only via said second port" and "said peripheral device is electrically connected to the system board only via said inward-facing port", respectively. However, the specification does not appear to provide basis for the exclusion of other electrical connections within the peripheral device and the system board.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13, 3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Takase et al. (US 6,261,107).

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Takase discloses a system board (2) comprising a connector (6) that includes a first port (15) situated at an exterior edge of the system board and facing outward from the exterior edge (shown at 70 in Fig.1); and a second port (surrounding 18) facing inward to an interior of the system board.

Regarding claim 3, Takase discloses the ports being substantially functionally identical.

Regarding claim 7, Takase discloses a peripheral device (5) operationally connected to the inward facing port.

Regarding claims 8-10, Takase discloses the system board being part of a portable computer (col.8 line 57).

Claims 13, 3, 4, 7-10, and 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Stout et al. (US 6,612,874).

Stout discloses a system (inside 10) comprising a connector (16) that includes: a first port (12) situated at an exterior edge of the system board and facing outward from the exterior edge; and a second port (18) facing inward to an interior of the system board.

Regarding claim 3, Stout discloses the ports being substantially functionally identical.

Regarding claim 4, Stout discloses the ports being USB ports.

Regarding claim 7, Stout discloses a peripheral device (14) operationally connected to the inward facing port. Please note that "operational" does not require direct mechanical connection.

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Regarding claims 8-10, Stout discloses the system board being part of a portable computer / mobile device.

Regarding claim 14 and 18, Stout discloses the second port facing inward to accommodate a peripheral device that is electrically connected to the system board via the second port.

Regarding claim 15, Stout discloses the first and second ports facing first and second directions that are parallel to the system board.

Regarding claim 16, Stout discloses the first and second directions being opposite directions.

Regarding claim 17, Stout discloses a mechanism, which is not one of the ports, whereby the connector is attached to the circuit board. Please note that part of the connector (at 12) inherently requires an attachment mechanism to the system board.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takase.

Takase discloses substantially the claimed invention except for the specific connector type. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to elect a specific connector type, such as a USB

connector base on environmental requirements/preferences, in order to provide a space efficient assembly.

### ***Response to Arguments***

Applicant's arguments filed December 7, 2004 and February 3, 2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments that Takase does not teach a "port" as defined in the specification, it is noted that definition is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Nonetheless, it is noted that the "definition", provided in page 3 line 23 to page 4 line 3, does not clarify the term but rather makes it unclear. For example, the phrase "typically but not necessarily" obscures what is meant to be cover by the claim and /or such "definition". Please note that where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). In this case the term/definition is indefinite because the specification does not clearly redefine the term.

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Additionally, it is noted that the "definition" merely requires that the port "facilitates... connection to a peripheral device" and not receiving a connector of the peripheral device.

In response to Applicant's arguments that the "engagement portion 14 of connector 6 faces downward, towards the system board 2, not inward relative to the system board 2", please note that port 14 faces inward to at least one inner point of the system board, thus meeting the claimed language.

In response to Applicant's arguments regarding the definition of "peripheral", please note that in Takase the connection between the second port and connector 5 is optional and removable. If the connection is not necessary then the second port and the connector 5 are not engaged with each other.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 Ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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